

## **REMARKS**

### **I. INTRODUCTION**

Favorable reconsideration of this application, in light of the present amendments and the following discussion, is respectfully requested.

### **II. STATUS OF THE CLAIMS**

By the present amendment, Claims 1-12 are cancelled and Claims 13-15 are added. That leaves Claims 13-15 pending with Claim 13 being independent. It is respectfully submitted that no new matter is added by this amendment.

### **III. SUMMARY OF THE OFFICE ACTION**

In the Office Action, the specification is objected under 35 U.S.C. § 132(a) for introducing new matter into the disclosure; Claims 1, 2 and 9 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; and Claims 1, 2, 5, 9 and 12 are rejected under 35 U.S.C. § 102(e) as anticipated by *Reiche et al.* (U.S. Patent No. 7,174,803).

### **IV. SPECIFICATION**

The specification is objected to under 35 U.S.C. § 132(a) for introducing new matter into the disclosure. Specifically, Figure 7 and the description thereof are objected to as allegedly being new matter. Applicant respectfully traverses.

In response to the objection, Applicant submits that new Figure 7 does not introduce new matter because the original disclosure describes the deformations on the fastening cage, as depicted in Figure 7. More specifically, page 3, lines 4-6, of the original disclosure describes that the “cage is clamped to the male member by means of *protrusion-like deformations on the lateral surface thereof*” (emphasis added). Additionally, page 5, lines 23-25 of the original disclosure states that the “cage (11) is clamped to the male member (4) by means of *protrusion-like deformations* (not shown) *on the lateral surface thereof*.” (emphasis added). Furthermore, original Claim 2 recites that “said cage is clamped to the outside of the male member by deformations on the lateral surface thereof.”

Therefore, the original specification describes that (a) the cage includes deformations; (b) the structure of the deformations is protrusion-like; and (c) the deformations are located on the lateral surface of the cage. It is those features that are depicted in Figure 7. Thus, contrary to the suggestion in the Office Action, the original specification provides support for the specific dimensioning and positioning of the deformations, that is deformations that are protrusion-like and specifically positioned on the lateral surface of the cage.

Accordingly, Applicant requests reconsideration and withdrawal of the objection to the specification and entrance of new Figure 7 and the corresponding amendment to the specification.

**V. REJECTIONS OF CLAIMS**

**A. Rejection of Claims 1, 2, and 9 under 35 U.S.C. §112, second paragraph**

Claims 1, 2, and 9 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Claims 1, 2 and 9 are cancelled by the present amendment, thereby rendering the rejection under 35 U.S.C. 112, second paragraph, moot.

**B. Rejection of Claims 1, 2, 5, 9, and 12 under 35 U.S.C. § 102(e)**

Claims 1, 2, 5, 9, and 12 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Reiche*. Applicant respectfully traverses. Because Claims 1, 2, 5, 9 and 12 are cancelled by the present amendment, Applicant addresses this rejection with respect to new independent Claim 13.

Independent Claim 13 recites a low sliding load intermediate shaft for a motor vehicle steering column, comprising:

a female member slidably receiving a male member therein, said female and male members having a substantially triangular shape with blunt vertexes;

a plurality of metal strips separate from said male member, each of said metal strips having an uneven contact surface; and

a continuous fastening cage fitted between said female member and said male member, said fastening cage having sides corresponding to sides of said triangular shape of said female and male members, said fastening cage having a plurality of recesses, each of said recesses being individually arranged on said sides of said fastening cage, respectively, corresponding to said sides of said triangular shape, and

wherein each of said metal strips being received in each of said plurality of recesses, respectively, such that said metal strips are distributed on each of said sides of said triangular shape of said female and male members.

In the Office Action, on page 6 under the “Response to Arguments” section, the Examiner noted that Claim 1 did not recite that “the metal strips are distributed on each of the sides of the triangular shape because the limitations do not precisely define which recess each strip is being put into.” In response, new Claim 13 recites that “said metal strips are distributed one each of said sides of said triangular shape”, as seen above. Moreover, new claim 13 recites that the fastening cage has a plurality of recesses with “each of said recesses being individually arranged on said sides of said fastening cage” ... “wherein each of said metal strips being received in each of said plurality of recesses, respectively.” Therefore, the metal strips of the claimed invention are distributed on each side of the fastening cage corresponding to the triangular shape of the members in respective recesses of the fastening cage.

In contrast to new Claim 13, *Reiche* teaches using a spring 9 disposed in chamber 8 at only one side of the inner and outer shaft parts 2 and 3, as seen in Figure 6. The claimed invention, on the other hand, recites a plurality of strips and a plurality of recesses, wherein the strips and recesses are distributed to correspond to sides of the triangular shape. Although Figure 5 of *Reiche* shows two springs, those springs are disposed on the same side of the cage and are not arranged to correspond to sides of a triangular shape of inner and outer shaft parts, as recited in the claimed invention.

Anticipation requires that every limitation of a claim must identically appear in a prior art reference. See *Gechter v. Davidson*, 43 U.S.P.Q. 2d 1030, 1032 (Fed. Cir. 1997). In this case, at least the limitation of a plurality of metal strips distributed on each side of the fastening cage in

respective recesses thereof, does not identically appear in *Reiche*. Absence from the prior art reference of any claimed element negates anticipation. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

Consequently, because all of the claim limitations of independent Claim 13 are not identically found in *Reiche*, Applicant submits that *Reiche* fails to anticipate the claimed invention. Therefore, Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b).

#### **VI. NEW CLAIMS**

New Claims 13-15 are added by the present amendment. New independent Claim 13 is similar to cancelled independent Claim 5, and new dependent Claims 14 and 15 are similar to cancelled dependent Claims 2 and 12, respectively.

As discussed above, Applicant submits that independent Claim 13 is allowable over the prior art of record including *Reiche*. Moreover, dependent Claims 14 and 15 are allowable for the same reasons and also recite additional features not found in the prior art.

#### **VII. CONCLUSION**

Consequently, in view of the foregoing discussion and present amendments, it is respectfully submitted that this application is in condition for allowance. An early and favorable action is therefore respectfully requested.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (001058-00031). A petition for a one-month extension of time is

submitted herewith. In the event that an additional petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, Applicant hereby petitions under 37 C.F.R. §1.36 (a) for an extension of time for as many months as are required to render this submission timely. Any fee due is authorized above.

Respectfully submitted,

BLANK ROME LLP

By: /Tara L. Marcus/  
Tara L. Marcus  
Reg. No. 46,510

600 New Hampshire Ave., N.W.  
Washington, D.C. 20037  
Telephone: (202) 772-5800  
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